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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,452	10/20/2003	Jack K. Hosking	1425.67029	4183

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EXAMINER

LE, MARK T

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,452

Applicant(s)

HOSKING ET AL.

Examiner

Mark T. Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 17-20 is/are allowed.
- 6) ☒ Claim(s) 6-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/2/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election with traverse of Group I, claims 1-15, in the reply filed on October 18, 2004, is acknowledged. The traversal is on the ground(s) that all of the features of combination claim 1 are found in the preambles of claims 17, 18, and 21, and each of these claims has been amended to recite a structural interrelationship with the combination of claim 1; therefore, the second leg of the test under MPEP 806.05(c) is not met as argued by Applicant. This is found to be persuasive with respect to only claims 17-20, but not with the amended claim 21, because the instant claimed jaw of claim 21 is not required to be in a positive structural relationship with the elements of the rail fastener driving apparatus. Regarding Applicant's arguments directed to the lacking of serious burden, and to the indicated classification of the groups of invention, note that the present Groups of invention may be classifiable in the same class; however, the searches required for the different groups are not necessarily the same, i.e. the searches for the jaw element of claim 21 may require an extensive search from other areas because a similar jaw element may be usable in other devices of classes 74, 81, 294 and 901. Therefore, it would be a serious burden imposed upon the examiner to consider all groups of invention including the invention drawn to the jaw member. In conclusion, claims 17-20 have amended such that they can be considered together with claims 1-15 without a serious burden, and claim 21 is maintained as withdrawn.

The requirement, at least with respect to claim 21, is still deemed proper and is therefore made FINAL.

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2. In the specification, the last two lines of page 11, reference numeral 118 is used to indicate a jaw mount or a jaw mount block; however, the lead line of reference numeral 118, as shown in Figure 4 of the instant drawings, is not directed to the jaw mount or jaw mount block as described in the specification. Proper correction is required.

In the specification, page 11, lines 10-13, the description "A central section 98 ... as is known in the art" is noted; however, it is not clear as to what structure in said description is admitted to be known in the art. Applicant is suggested to specifically point out what is said to be known in the art so that proper treatment of the admitted prior art can be made.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 6-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, on page 11 of the instant specification, lines 15-17, the description "The spring rod 102 is configured to bias the jaw mount support 88 in an operational position (FIG. 6) toward the track and in the direction of travel of the machine 10 along the track" is noted and read in light of the corresponding structure shown in Figure 6 of the instant drawings; however, it is not clear as to how jaw mount

support 88 is capable of being pivotable about axis 89 with spring rod 102 being only capable of sliding in vertical directions, and it is not clear as to how the jaw mount support is moved in the direction of travel of machine 10, as described.

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 6-15 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Specifically, it appears that that spring rod 102, arranged in the manner as shown in Figure 6 of the instant drawings, cannot bias jaw mount support 88 in an operational position toward the track and in the direction of travel of the machine 10 along the track.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 11 and 15 (as best can be determined) are rejected under 35 U.S.C. 102(b) as being anticipated by Woolner (US 4,273,052).

Woolner discloses a rail fastener driver apparatus having all the features as recited in the instant claims, including elements 80, 100 and 111 that form a fastener holder; wherein, element 11 is configured for movement between a first receiving position and a second position for driving, and elements 80 and 100 are configured for biased by springs 86 and pivotal movements about axes 81, 101.

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Regarding claim 15, consider the biasing force provided by extending rod 103.

9. Claims 1-5 and 17-20 are allowable

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Le whose telephone number is 703-308-3663. The examiner can normally be reached on Mon-Fri (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark T. Le
Primary Examiner
Art Unit 3617

mle
11/22/04